

## REMARKS

### Restriction Requirement

In the above-identified Office Action, the examiner set forth a restriction requirement and required election of one of the following groups under 35 U.S.C. § 121:

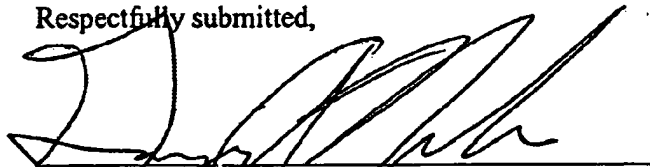
- Group I: Claims 1-8, drawn to a method of detecting cancer through nucleic acid expression detection, classified in class 435, subclass 6.
- Group II: Claims 1 and 9-12, drawn to a method of detecting cancer through protein expression detection, classified in Class 435, subclass 7.1.
- Group III: Claims 1 and 11-15, drawn to a method of detecting cancer through expression detection via antibodies, classified in Class 435, subclass 7.1.
- Group IV: Claims 16-19, drawn to a method of modulating Fra-1 gene expression with antisense oligonucleotides, classified in Class 514, subclass 44.
- Group V: Claims 20-26, 28-33, drawn to method of inhibiting VEGF-D gene expression by introducing a protein as classified in Class 435, subclass 7.1.
- Group VI: Claims 20, 26, 27, and 30-33, drawn to a method of inhibiting VEGF-D gene expression by introducing an antisense oligonucleotide as classified in Class 514, subclass 44.
- Group VII: Claims 34-39, drawn to a method of identifying a test compound that modulates expression of a Fra-1 gene through detection with a Fra-1 nucleic acid gene marker classified in Class 435, subclass 6.
- Group VIII: Claims 34, 36, 40 and 41, drawn to a method of identifying a test compound that modulates expression of a Fra-1 gene through detection with a Fra-1 protein gene marker classified in Class 435, subclass 7.1.
- Group IX: Claims 42-47, drawn to a method of inhibiting angiogenesis by administering a protein to interfere with binding classified in Class 514, subclass 12.

In response, Applicants hereby elect Group VIII (Claims 34, 36, 40 and 41), drawn to a method of identifying a test compound that modulates expression of a Fra-1 gene through detection with a Fra-1 protein gene marker classified in Class 435, subclass 7.1. This election is made without traverse.

The elected claims set forth, herein, are merely to comply with the Restriction Requirement and is not to be construed as surrender of any subject matter in the instant application. Applicants hereby reserve the right to pursue the subject matter of the canceled claims in one or more divisional patent applications. Based on the above election, Applicants request removal of the restriction requirement and substantive examination of all elected claims. Applicants invite the Examiner to call the undersigned if it is believed that the above restriction election is incomplete or improper in any way, or if a telephonic interview will expedite the prosecution of the application to an allowance.

Dated: 10/6/04

Respectfully submitted,



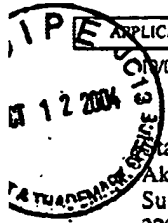
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Docket No. 6460-40



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
07/075,499	02/12/2002	Waldemar Debinski	6460-40	8794

7590 09/08/2004  
Stanley A. Kim, Ph.D., Esq.  
Akerman, Senterfitt & Eidson, P.A.  
Suite 400  
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EXAMINER

SAKELARIS, SALLY A

ART UNIT PAPER NUMBER

1634

DATE MAILED: 09/08/2004

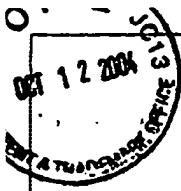
Please find below and/or attached an Office communication concerning this application or proceeding.

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SEP 13 2004

AKERMAN SENTERFITT & EIDSON

DOCKETED



Office Action Summary

Application No. 10/075,499	Applicant(s) DEBINSKI ET AL.	
Examiner Sally A Sakelaris	Art Unit 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a method of detecting cancer through nucleic acid expression detection, classified in class 435, subclass 6.
- II. Claims 1 and 9-12, drawn to a method of detecting cancer through protein expression detection, classified in Class 435, subclass 7.1
- III. Claims 1 and 11-15, drawn to a method of detecting cancer through expression detection via antibodies, classified in Class 435, subclass 7.1.
- IV. Claims 16-19, drawn to a method of modulating Fra-1 gene expression with antisense oligonucleotides, classified in Class 514, subclass 44.
- V. Claims 20-26, 28-33, drawn to method of inhibiting VEGF-D gene expression by introducing a protein as classified in Class 435, subclass 7.1.
- VI. Claims 20, 26, 27, and 30-33, drawn to a method of inhibiting VEGF-D gene expression by introducing an antisense oligonucleotide as classified in Class 514, subclass 44.
- VII. Claims 34-39, drawn to a method of identifying a test compound that modulates expression of a Fra-1 gene through detection with a Fra-1 nucleic acid gene marker classified in Class 435, subclass 6.
- VIII. Claims 34, 36, 40 and 41, drawn to a method of identifying a test compound that modulates expression of a Fra-1 gene through detection with a Fra-1 protein gene marker classified in Class 435, subclass 7.1.

IX. Claims 42-47, drawn to a method of inhibiting angiogenesis by administering a protein to interfere with binding classified in Class 514 subclass 12.

1. The inventions of Groups I-IX are patentably distinct methods because they each have different objectives, different uses, different reagents and different method steps. Group I is drawn to a method of detecting cancer through nucleic acid expression detection. Group II is drawn to a method of detecting cancer through protein expression detection. Group III drawn to a method of detecting cancer through expression detection via antibodies. Group IV is drawn to a method of modulating Fra-1 gene expression with antisense oligonucleotides. Group V is drawn to method of inhibiting VEGF-D gene expression by introducing a protein. Group VI is drawn to a method of inhibiting VEGF-D gene expression by introducing an antisense oligonucleotide. Group VII is drawn to a method of identifying a test compound that modulates expression of a Fra-1 gene through detection with a Fra-1 nucleic acid gene marker. Group VIII is drawn to a method of identifying a test compound that modulates expression of a Fra-1 gene through detection with a Fra-1 protein gene marker. Finally Group IX is drawn to a method of inhibiting angiogenesis by administering a protein to interfere with binding. The methods all have different method steps, objectives and reagents. Therefore the methods are distinct over one another.

2. Claim 1 links inventions I-III. Claims 20, 26, and 30-33 link inventions V and VI. Claims 34 and 36 link inventions VII and VIII. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claims, claims 1, 20, 26, 30-33, 34, and 36(respective to each elected group). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or

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otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classifications and their divergent subject matter and because these inventions require different searches that are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally A Sakelaris whose telephone number is 571-272-0748. The examiner can normally be reached on M-Fri, 9-6:30 1st Friday off.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sally Sakelaris

9/3/2004

  
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SUPERVISORY PATENT EXAMINER  
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